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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,726	01/17/2002	Allan Paul Uy	ST01015USU(133-US-U1)	8643

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EXAMINER	
KAPLAN, HAL IRA	

ART UNIT	PAPER NUMBER
2836	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/051,726	UY ET AL.	
	Examiner	Art Unit	
	Hal I. Kaplan	2836	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 November 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *17 June 2008* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 212 in Figure 2 (see the amendment to the Specification filed November 21, 2008). In addition, the reference numerals 112 and 212 are both used to describe the voltage source V2. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (admission) in view of the US patent of Wagner (4,788,450).

As to claims 1 and 6, admission teaches all of the claimed features except for the claimed FET coupled to the secondary power source and the claimed inverter coupled to a gate of the FET (see Figure 1). Wagner discloses an apparatus for providing power from a secondary power source comprising a FET (310) coupled to the secondary power source (350) and to a device to be powered (316); and an inverter (381), coupled

to a gate of the FET (310), wherein the inverter (381) maintains the FET (310) in a pinched-off condition and preventing a current flow from the secondary power source (350) when the primary power source (306) is available (see column 5, lines 1-3; column 5, line 66 - column 6, line 26; and Figure 3). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified admission by connecting the FET (310) of Wagner between the first diode and the secondary power source, and connecting the inverter (381) of Wagner between the FET (310) and the switch (114) of admission, with its control signal coupled directly to the primary power source, in order to completely isolate the secondary source when the primary source is present, thus preventing the secondary source from unnecessary depletion. Admission in view of Wagner do not disclose the relative potentials of the primary and secondary power sources; however, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of admission in view of Wagner by selecting primary and secondary power sources wherein the secondary power source has a lower potential than the primary source, because selections of values of components and operational levels for an electronic device are engineering decisions based upon the system's intended use and the expected requirements of the other systems with which it will interface. See MPEP §2144.04(IV)(A). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform

differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

As to claims 2-5 and 7-10, the FET of Wagner may be either n-channel or p-channel (see column 8, lines 7-10), but Wagner does not specify whether the FET is a depletion mode FET or an enhancement mode FET. In the Office action dated December 24, 2003, the Examiner took official notice that n-channel depletion mode FETS and p-channel enhancement mode FETS are well-known switching equivalents in the art of semiconductor power switching. Thus, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the circuit of admission in view of Wagner by using either depletion mode or enhancement mode FETS, because they are well-known in the art as switching equivalents.

Response to Arguments

6. Applicant's arguments filed November 21, 2008 have been fully considered but they are not persuasive.

The Applicants state that engineering decisions referred to in MPEP 2144.04(IV)(A) are characteristics such as dimensions or operational voltages and do not apply to the cited references. The Examiner respectfully disagrees. The relative potentials of the first and second power sources are operational voltages and are thus engineering decisions which do not create a patentable distinction. Although the cited references maintain power at a fixed voltage or higher voltage, it would be readily apparent to one of ordinary skill in the art that a field effect transistor can be used to

prevent current flow from a secondary power source with a lower potential than a primary power source when the primary power source is available.

The Applicants also state that the '450 patent fails to describe a circuit that prevents a current flow from the secondary power source where the primary power source is available. The Examiner respectfully disagrees. The inverter (381) of the '450 patent ensures that current only flows from one of the power sources at a time by opening switch 310 when the primary power source is available (see column 5, line 66 - column 6, line 26). When the primary power source is available, transistor 310 does not conduct, and current does not flow from the secondary power source (350).

The Applicants also state that the Examiner's cited combination requires a voltage detector element that increases the complexity and cost of any resulting circuits. The Examiner respectfully disagrees. Neither of the cited references includes a voltage detector element, and there is no reason why a voltage detector element would be needed to switch between power supplies when one power supply becomes available and the other becomes unavailable.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The US patents of Armstrong II et al. (5,187,396), Willis (5,598,041), Staffiere (6,137,192), Kohda (6,420,906), and Winick et al. (6,462,434) disclose similar backup power supply systems.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hal I. Kaplan whose telephone number is 571-272-8587. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Elms can be reached on 571-272-1869. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

hik

/Albert W Paladini/

Primary Examiner, Art Unit 2836 2/6/09